

REMARKS

Reconsideration of the pending application is respectfully requested on the basis of the following particulars:

1. Amendments and Support for Same

Independent claims 1-2, 4, and 43-44 have been amended to more particularly point out and distinctly claim the subject matter of the invention. More specifically, claims 1-2, 4, and 43-44 have been amended by further reciting all of the features of claims 27 and 28. As amended, the claims clarify that the storage control portions controls the restoring part to select portions from the content received that are predetermined as previewable and to create a preview. Claims 3, 14, and 27-28 have been cancelled. No new matter has been added. Accordingly, claims 1-2, 4-13, 15-26, and 29-44 are respectfully submitted for consideration. Approval and entry of the amendments are respectfully requested.

2. Claims rejections under 35 U.S.C. 101:

With respect to the rejection of claim 4 under 35 U.S.C. 101 because it claims a storage medium but does not recite that the instructions stored thereon may cause a computer to execute the recited steps, Applicant has amended the claim to recite steps overcome the rejection. Accordingly, Applicant respectfully requests reconsideration and withdrawal of the §101 rejection of claim 4.

3. Claim rejections under 35 U.S.C. 102(b):

With respect to the rejection of claims 1-25, 27-30, 36-41 and 43-44 under 35 U.S.C. §102(b) as being anticipated by Russo (US 6,025,868), Applicant respectfully traverses the rejection at least for the reason that Russo fails describe each and every limitation recited in the rejected claims.

As amended, all independent claims 1-2, 4, and 43-44 further clarify that the storage control selects portions from the content received that are predetermined as previewable and to create a preview, and selectively stores a preview of a pre-viewable pay-per-view content selected from the transmitted content.

According to the embodiments of claims 1-2, 4, and 43-44, the present invention provides a preview for a pay-per-view program. Based on the descriptions and definition of the term preview set forth in the specification, a preview generally is a selected portion of an audio/video program that allows a viewer an opportunity to see certain highlights of a program without allowing the viewer to know an ending to program, answers to a quiz show, a mature content of a program, and etc. Such a preview enables the viewer to decide if a program is worth viewing or paying for or not, for example.

In other words, a part of pay-per-view contents is clipped or selected from the content transmitted, and the preview is stored selectively separate from the entire transmitted content. Consequently, users can watch a preview of any pre-viewable pay-per-view content immediately without download or accessing server and utilize the data to playback of the whole program.

As claimed, the present invention directed to a storage-type receiving device and method include storing a received content in a storage part, a restoring part for restoring the content received, a control part controlling the restoring part. The device and method further includes a storage control portion for judging whether or not the content is a pay-per-view content, and for controlling the restoring part to select a part of the content as a preview, and selectively storing the preview that has been selected from the transmitted content. As shown in Fig. 14 and page 32, lines 2-3 of the specification, for example, the present invention includes storage of a preview program, which is separate and distinct from storing an entire content received in the storage part.

In contrast with the presently claimed invention, Russo generally describes a device and method for a pay-per-play program. It is an object of Russo to allow a stored program to be substantially viewed before payment is considered as due so that a view is not limited to contiguous viewing. According to Russo, payment will preferably come due once the majority or some percentage of the program has been watched.

Col. 5, lines 33-40 of Russo states the following:

Alternatively, payment may be transferred or ear-marked to the provider once a program is selected for viewing, but if viewing were to be terminated shortly thereafter and never resumed, the system might automatically re-credit the subscriber for that program, since it was largely unwatched. Such a scheme is in keeping with allowing a viewer to enjoy a free "**preview**" of a program, as described elsewhere herein. [Emphasis added]

Applicant respectfully asserts that Russo disclose only recording of the whole program but does not disclose recording only partial contents selectively (i.e., portions that are selectively read out from the content received, that are predetermined as previewable, and that are used to create a preview from transmitted pay-per-view contents) as the above-mentioned characteristic of Applicant's claim 1, for example.

Further, Applicant respectfully submits that Russo consistently uses the terminology "preview" in quotations so as to indicate that the "preview" of Russo is has a specific meaning in accordance with the spirit of Russo's invention, which is to not charge for viewing of a program unless it is substantially viewed. That is, according to Russo, partially viewed program is considered as a "preview" and is, therefore, not charged. Taking the meaning of "preview" in proper context of the invention of Russo, Applicant respectfully asserts that the "preview" of Russo does not indicate a conventional meaning of a preview (e.g., trailer) that is well known in the art or the preview in accordance with Applicant's claimed invention, which includes portions selected from a transmitted program (i.e., content) and which are selectively stored as a preview.

Applicant respectfully asserts that, although Russo describes storing an entire pay-per-play program for viewing at a user's convenience, Russo fails to teach, disclose, or suggest selectively storing a preview of a pre-viewable pay-per-view content selected from a transmitted content, as recited in the pending claims.

In the rejection, the Examiner contends that "the system also selectively stores or automatically erases content (para. 45)". However, Applicant respectfully asserts that the erasing process disclosed in Russo appears to be performed, for example, after recording the whole program.

Further, the Examiner argues that “the point at which the user left off viewing is tracked in order to selectively restore the viewing of the content (para. 45)”. However, Russo actually discusses tracking the stopping point in the whole pay-per-play program to ensure that a viewer is not charged when the individual cannot finish a particular program, as disclosed in paragraph 45 of Russo.

As mentioned above, Russo discloses only that the whole program is stored, and a “preview” means that a viewer unable to view the program substantially entirely and, therefore, is not charged. Further, the “preview information” of Russo means just the position of a viewed portion of a whole program. As Russo does not have the ability to selectively storing portions of the transmitted program as a preview, Russo cannot control which portions of a program a user may not view, such as, for example, mature content, answers in a quiz show, etc.

Should the Examiner continues to allege that Russo teaches, disclose, or suggest previewing as claimed in Applicant’s invention, Applicant would respectfully request the Examiner to provide concrete evidence supporting at least a features of selecting portions from the content received that are predetermined as previewable and to create a preview, and selectively storing a preview of a pre-viewable content selected from the transmitted content, as recited in Applicant’s amended claims 1-2, 4, and 43-44.

Consequently, since each and every feature of the present claims is not taught (and is not inherent) in Russo, as is required by MPEP Chapter 2131 in order to establish anticipation, the rejection of claims 1, 4-6, and 10, under 35 U.S.C. §102(b), as anticipated by Russo is improper.

In view of the amendment and arguments set forth above, Applicant respectfully requests the Examiner to consider Russo in its entirety as set forth in MPEP 2141.02(VI). Further, Applicant respectfully requests reconsideration and withdrawal of the §102(b) rejection of claims 1-2, 4, and 43-44.

#### 4. Claim rejections under 35 U.S.C. 103(a)

With respect to the rejection of claims 31-35 and 42 under 35 U.S.C. 103(a) as being unpatentable over Russo, and to the rejection of claim 26 under 35 U.S.C. 103(a) as being

unpatentable over Russo in view of Yurt ( U.S. 5,132,992), Applicant respectfully traverses the rejection at least for the reasons set forth above in relation to the §102(b) rejection of independent claims 1-2, 4, and 43-44 above, and for the reason that Russo and Yurt, combined or separately, fail to teach, disclose, or suggest all of the limitation recited in the rejected claims.

Yurt is cited by the Examiner for describing a buffering process. However, Yurt fails to teach, disclose or suggest at least selectively storing a preview of a pre-viewable content selected from the transmitted content, as recited in Applicant's amended claims 1-2, 4, and 43-44. Hence, Russo and Yurt, separately or combined, fail to teach, disclose, or suggest all of the features of the rejected claims.

The requirements for establishing a *prima facie* case of obviousness, as detailed in MPEP § 2143 - 2143.03 (pages 2100-122 - 2100-136), are: first, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference to combine the teachings; second, there must be a reasonable expectation of success; and, finally, the prior art reference (or references when combined) must teach or suggest all of the claim limitations.

Further, according to MPEP §2141(I), Patent examiners carry the responsibility of making sure that the standard of patentability enunciated by the Supreme Court and by the Congress is applied in each and every case. The Supreme Court in *Graham v. John Deere*, 383 U.S. 1, 148 USPQ 459 (1966), stated:

Under § 103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background, the obviousness or nonobviousness of the subject matter is determined. Such secondary considerations as commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented.

Moreover, according to MPEP §2141(II), when applying 35 U.S.C. §103, the following tenets of patent law must be adhered to:

(A) The claimed invention must be considered as a whole;

(B) The references must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination;

(C) The references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention; and

(D) Reasonable expectation of success is the standard with which obviousness is determined.

In view the amendments and argument set forth above, Applicant respectfully requests the Examiner to follow tenets A-D in combining Russo and Yurt. Applicant further respectfully requests reconsideration of the obviousness rejections of claims 26, 31-35, and 42 over Russo or the combination of Russo and Yurt.

#### 5. Conclusion

In view of the amendments to the claims, and in further view of the foregoing remarks, it is respectfully submitted that the application is in condition for allowance. Accordingly, it is requested that claims 1-2, 4-13, 15-26, and 29-44 be allowed and the application be passed to issue.

If any issues remain that may be resolved by a telephone or facsimile communication with the Applicant's representative, the Examiner is invited to contact the undersigned at the numbers shown.

Further, while no fees are believed to be due, the Commissioner is hereby authorized to charge any additional fees which may be required, or credit any overpayment to Deposit Account No. 50-4525.

If any issues remain that may be resolved by a telephone or facsimile communication with the Applicant's representative, the Examiner is invited to contact the undersigned

Respectfully submitted,

/Donald R. Studebaker/  
Donald R. Studebaker  
Registration No. 32,815

Studebaker & Brackett PC  
1890 Preston White Drive  
Suite 105  
Reston, Virginia 20191  
(703) 390-9051  
Fax: (703) 390-1277  
don.studebaker@sbpatentlaw.com